

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended by limiting component (B) to the tertiary amine of formula (2), as supported in the specification at page 16, line 6, and by inserting a weight ratio of (A) to (B), as supported in the specification at page 22, last paragraph.

New Claims 16 and 17 have been added. Claims 16 and 17 are supported by the Examples in Table 1 of the specification.

No new matter is believed to have been added by the above amendment. Claims 1-17 are now pending in the application.

REMARKS

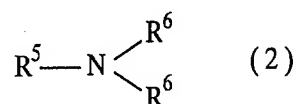
Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2005/0255074, when discussing the application description, rather than to page and line of the specification as filed.

The rejection of Claims 1, 3, 9, 11 and 13 under 35 U.S.C. § 103(a) as unpatentable over “combined teachings of” US 6,086,663 (Kondo et al) and JP 1997-151119 (Ando et al), is respectfully traversed.

As recited in above-amended Claim 1, an embodiment of the present invention is a hair cosmetic comprising the following components (A) and (B):

(A) organopolysiloxane having an amino-modified organopolysiloxane chain and a polyoxyalkylene chain,

(B) a tertiary amine compound represented by formula (2):



wherein R⁵ represents a linear or branched alkyl or alkenyl group containing 8 to 35 carbon atoms in total, which may be interrupted by a functional group represented by -O-, -CONH-, -OCO- or -COO- or substituted with -OH; R⁶ represents a C1 to C22 alkyl, alkenyl or hydroxyalkyl group, and two R⁶s may be the same as, or different from, each other, wherein (A) and (B) are present in a weight ratio of 10/1 to 1/10.

The hair cosmetic of the present invention is disclosed as useful in suppressing a frictional feeling of hair during rinsing in running water and improving the softness and smoothness of hair during rinsing, as described in the specification at paragraph [0001].

As described in the specification at paragraph [0003], conventionally, cationic compounds such as cationic surfactants and cationic polymers, lubricants, silicones, etc. have been used to improve smoothness during rinsing, but the effect of the cationic surfactants and polymers on suppression of a feeling of a friction in water is limited, and is poor in an ability to confer softness and smoothness. The lubricants hardly suppress a feeling of friction in running water, and dimethyl polysiloxane can be said to be absent in an ability to suppress a feeling of friction in running water and in an ability to confer softness and smoothness. Among the silicones, a polyether-modified silicone is poor in an ability to confer a feeling of softness, and the ability thereof to suppress a feeling of friction and to confer smoothness is not durable. An amino-modified silicone can confer a lasting feeling of softness, but cancels the feeling of selfness because of its feeling of friction similar to the feeling of strong rubber in running water.

The present invention addresses the problems of the prior art.

Kondo et al is drawn to a surface modifier composition whose base ingredient is an amidepolyether-modified organopolysiloxane that exhibits an excellent blending stability with respect to cosmetics, lubricants, lustrants, antifoams, fiber-treatment agents, and paints, and that can provide an excellent use sensation, surface protection, transparency in blending, antistatic properties, and surface lubricity (column 1, lines 17-25). The Examiner relies on Comparative Example 6 therein, which describes a comparative surface modifier composition containing, *inter alia*, an amino-modified polysiloxane, stearyltrimethylammonium chloride, and cetyl alcohol. As shown in Tables 1-3 of Kondo et al, the surface modifier composition of Comparative Example 6 is inferior to Examples 1-3 according to Kondo et al's invention with regard to antistaticity, flexibility, smoothness, oily feel, and raspiness when damp.

Ando et al discloses a hair cosmetic ingredient capable of exerting an antistatic effect on hair [0005], which is a specified reactive silicone-type block copolymer of a particular

formula, represented as “Chemical 2” therein [0007]. While Ando et al discloses that it is possible to mix additives routinely mixed with hair cosmetic ingredients so long as they do not adversely affect the effects of their invention, no tertiary amine, let alone those of presently-recited component (B), are disclosed therein [0019].

The Examiner holds that it would have been *prima facie* obvious “to have incorporated the amino-modified organopolysiloxane component of [Ando et al] **into the invention** practiced by [Kondo et al], particularly since both inventions are directed to the creation of cosmetic compositions, more specifically hair care products” (Emphasis added.)

In reply, if one of ordinary skill in the art were to incorporate the amino-modified organopolysiloxane component of Ando et al into the invention practiced by Kondo et al, the result would not be the presently-claimed invention. As discussed above, Kondo et al relates to the use of an **amide** polyether-modified organopolysiloxane, **not** an **amino**-modified polysiloxane. Indeed, in view of the inferiority demonstrated by Comparative Example 6 of Kondo et al, there would be **no** motivation to modify Comparative Example 6 at all; rather, Comparative Example 6 would simply be discarded as, in effect, a failed experiment. It is only with the present disclosure as a guide that one of ordinary skill in the art would combine the reactive silicone-type block copolymer of Ando et al with the particular cationic surfactant of formula (1) of previously-recited component (B) herein, especially when such compounds are conspicuously absent from Ando et al’s disclosure of other components which may be present, as discussed above. Nor does Comparative Example 6 of Kondo et al, or any other disclosure of Kondo et al, disclose or suggest the tertiary amine compound of formula (2), now a required component of the claims. Indeed, the applied prior art does not present a *prima facie* case of obviousness.

Nor could the applied prior art have predicted the improved results obtained when using presently-recited component (A), as shown by Products of the Invention 4 and 6-8

herein, compared to Comparative Product 3 which, instead of component (A) herein, employ either a dimethylpolysiloxane; the dimethylpolysiloxane and an amino-modified polysiloxane; a polyether modified polysiloxane; and the amino-modified polysiloxane, respectively. Compare the evaluation data in Table 1 for the Products of the Invention with the evaluation data in Table 2 for the Comparative Products at paragraphs [0106] and [0107] of the specification.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

Applicants respectfully traverse the new Restriction Requirement. Applicants note that the Examiner has found persuasive Applicants' Request for Reconsideration of the initial Restriction Requirement. The Examiner now enters a new requirement but Applicants respectfully submit that the new requirement is not clear. At any rate, the fact that presently-recited component (A) may not be novel *per se*, does not mean that the claims do not relate to a single general inventive concept under PCT Rule 13.1. Indeed, the special technical feature of the present invention is the **combination** of components (A) and (B). In addition, given the breadth of the disclosure in Ando et al of the reactive silicone-type block copolymer therein, there would appear to be little or no burden to examine all of the present claims. Therefore, Applicants respectfully request that either the new Restriction Requirement be withdrawn, and all of the presently-pending claims be examined on the merits or, if the present response does not otherwise result in an allowance of all pending claims, a new non-Final Office Action be entered that clarifies the new Restriction Requirement.

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Reply to Office Action of April 30, 2009

Applicants respectfully submit that all of the presently-pending claims are now in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Customer Number

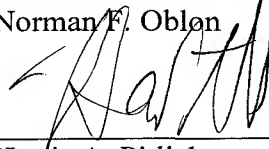
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